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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,841

03/28/2006

Kouji Tabata

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34238

7590

04/01/2009

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EXAMINER

FIGUEROA, JOHN J

ART UNIT

PAPER NUMBER

1796

MAIL DATE

DELIVERY MODE

04/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,841	Applicant(s) TABATA ET AL.	
	Examiner John J. Figueroa	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/28/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejected claim limits the content of the "polystyrene *domain*" of claim 4. There is insufficient antecedent basis for this limitation in the claim. It is also unclear as to what the term "domain" encompasses and whether Applicant actually intended to limit the amount of styrene in the copolymer and/or adhesive composition.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese Patent Publication Number JP 11-080690 A to Oji Paper, hereinafter 'Oji Paper' (submitted by Applicant in the IDS of March 28, 2006).

For purposes of this Office action, Examiner will be relying on the English translation of this Japanese Patent that was submitted by Applicant with the aforementioned IDS.

Oji Paper discloses a pressure sensitive adhesive sheet for use for laminating surface-base materials in rubber tire applications, wherein the pressure sensitive adhesive sheet comprises a synthetic resin containing 25-70 % by composition weight of (A), a composition containing natural rubber and a tackifier as the binder constituent for the tire; and 75 - 30 % of (B), an ABA mold block copolymer, wherein the ABA block copolymer block copolymer can be styrene-butadiene-styrene or styrene-isoprene-styrene (S-I-S). (Abstract; paragraph [0009] on page 2/9; paragraph [0010] on page 3/9; paragraph [0015] on page 4/9)) This adhesive composition provides excellent punch characteristics; non-blackening contamination of the substrate surface and thereby (inherently) enhanced peeling/loop adhesion properties. (Paragraph [0009] on page 3/9)

Oji Paper further discloses that suitable tackifiers can be natural resin, polyterpene system resin, aliphatic series system hydrocarbon resin, cyclopentadiene system resin, aromatic series system petroleum resin, phenol system resin, alkyl-phenol-acetylene series resin, cumarone-indene system resin and vinyltoluene-alpha-methyl-styrene copolymers, wherein the softening points for the tackifiers are 60-100°C. (Paragraph [0012] on page 3/9; the term "system" implies more than one tackifier) In addition, the adhesive composition can further contain a softener (plasticizer), such as oil (paraffin) in addition to other additives. (Paragraph [0016] on page 4/9) In the Examples in paragraphs [0020] to [0022] on page 5/9, Oji Paper discloses preparing an

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adhesive sheet wherein the plasticizer comprises 20% by weight of the composition and the substrate has a metal aluminum coating.

Thus, the rejected claims are anticipated by Oji Paper.

Allowable Subject Matter

5. Claims 4 and 5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form to overcome the 35 U.S.C. 112, second paragraph, rejection and including all of the limitations of the base claim and any intervening claims.

6. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record does not teach or suggest a hot-melt pressure sensitive adhesive sheet comprising the adhesive composition as recited in claim 3 that further contains a mixture of S-I-S block copolymer and styrene-isoprene copolymer in the weight percent by composition recited in claim 4.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Figueroa whose telephone number is (571)272-8916. The examiner can normally be reached on Monday-Thursday 8:00-6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James J. Seidleck/
Supervisory Patent Examiner, Art Unit 1796

JJF/JS